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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,874	06/29/2001	Lawrence Y. Fang	13615.40USU1	1026

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT PAPER NUMBER

1621

DATE MAILED: 07/30/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,874

Applicant(s)

Fang et al

Examiner

Shailendra Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 10, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-147 is/are pending in the application.
- 4a) Of the above, claim(s) 14, 15, 19, 20, 25, 26, and 31-143 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 28, 30, and 144-147 is/are rejected.
- 7) ☒ Claim(s) 6-13, 16-18, 21-24, 27, and 29 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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DETAILED ACTION

84 This office action is in response to applicants' communication filed in paper # 7, on 5/10/02.

1-147
Claims ~~1-147~~ are pending in this application.

At the outset, it is not clear as to who are the applicants. From the Declaration Fang et al appears to be the applicants, however, from applicants' response, it is Becker et al. Please clarify the inventorship.

Information Disclosure Statement

The information disclosure statement filed 10/22/01 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not include a concise explanation of the relevance. Since the disclosure statement is jumbo type with numerous reference, it is applicants' duty to supply the relevance of the most relevant references . It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 C(1).

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1. Applicants' election of Group I, claims 1-30 and 144-147 have been noted. Since otherwise not mentioned, it is taken for granted that the election is without traverse. Thus claims 31-143 stand withdrawn from the consideration, being drawn to the non elected invention. Applicants' election of species of example 2 is acknowledged and claims 14-15, 19-20, and 25-26 are further withdrawn from the consideration being drawn to the non elected subject matter. It is advised that applicants cancel all the heterocyclic subject matter to advance the prosecution.
2. The elected species and all closely related compounds are free of prior art and would be allowed, if independently presented.
3. In view of the allowed species, search was extended to examine another species, i.e when R₁ is (VI), R₂ and R₃ are hydrogen, R_N is (II), and X is O, and R_A is (II).

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-5, 28, 30, and 144-147 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 9965870.

WO'870 teach structurally similar compounds as claimed herein. Note page 49, compound (III), and see the definition of A in Table 1, pages 24-26, 33-36, and also see compound of example 54 on page 156. In the instant claim, when R1 is benzyl, R2 and R3 are hydrogen, X is O, and RA is cycloalkyl, RN is -CO-alkyl, then, instant claims read on example 54 of the reference. The difference between the reference and herein claimed compounds is that the reference compounds subgenus of the claimed compounds, and are the intermediates for making the final product.

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It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic structure of the reference, because they are structurally similar to those claimed herein, with the reasonable expectation of achieving a successful intermediate for obtaining the final product, absent evidence to the contrary. As far as the composition goes, the carriers are well known, and see example 54, wherein the compound is either in water or in organic solvent.

7. US 4,935,405 is further cited to show the state of the art. See particularly, example 11 I column 17.

8. Claims 6-13, 16-18, 21-24, 27, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

It is again advised that applicants cancel all the non elected subject matter, including all the heterocyclic subject matter, and claims should be grouped around the elected species, so that claims can be allowed, and the prosecution can be advanced.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703)-308-4519. The examiner can normally be reached on Monday to Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Friday.

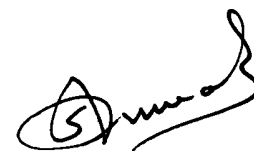
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703)-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1235.

S.Kumar

7/26/02



SHAIENDRA KUMAR
PRIMARY EXAMINER
GROUP 1200